

This Page Is Inserted by IFW Operations
and is not a part of the Official Record

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images may include (but are not limited to):

- BLACK BORDERS
- TEXT CUT OFF AT TOP, BOTTOM OR SIDES
- FADED TEXT
- ILLEGIBLE TEXT
- SKEWED/SLANTED IMAGES
- COLORED PHOTOS
- BLACK OR VERY BLACK AND WHITE DARK PHOTOS
- GRAY SCALE DOCUMENTS

IMAGES ARE BEST AVAILABLE COPY.

**As rescanning documents *will not* correct images,
please do not report the images to the
Image Problem Mailbox.**



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,266	05/10/2001	Shunpei Yamazaki	12732-035001 / US4908	5445

26171 7590 08/02/2004
FISH & RICHARDSON P.C.
1425 K STREET, N.W.
11TH FLOOR
WASHINGTON, DC 20005-3500

EXAMINER

EHICHIOYA, FRED I

ART UNIT PAPER NUMBER

2172

DATE MAILED: 08/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/852,266	YAMAZAKI ET AL.	
	Examiner	Art Unit	
	Fred I. Ehichioya	2172	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1 – 63 are pending in this office action.
2. New claims 23, and 55 – 63 are added.

Response to Arguments/Remarks

3. Applicants' remarks on page 15 of amendments filed June 1, 2004 with respect to Claims 1-20, 23, 25-36, 43-45, and 49-54 that have been rejected as being anticipated under section 102(e) by UK Patent Application GB 2 348 309 A to Uchida have been fully considered but are not persuasive.

Applicants cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

4. The rejections of Claims 1-20, 23, 25-36, 43-45, and 49-54 under 35 U.S.C. 102 (e) of last Office Action is a typographical error. The rejections of Claims 1-20, 23, 25-36, 43-45, and 49-54 are under 35 U.S.C. 102 (a). Therefore rejection of last Office Action is proper.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1 – 20, 23, 25 – 36, 43 – 45, and 49 - 54 are rejected under 35 U.S.C. 102(a) as been anticipated by UK Patent Application GB 2 348 309 A issues to Kaoru Uchida (hereinafter “Uchida”).

Regarding claims 1, 7, 11 and 17, Uchida teaches a communication system for distinguishing a user, said system comprising:

a storing means for storing reference living body information (see page 20, lines 13 – 17; Uchida discloses “fingerprint” as “living body”);

a reading means for reading collation living body information of the user (see page 21, lines 17 – 19);

a collating means for collating the collation living body information with the reference living body information (see page 22, lines 1 – 9; Uchida discloses “checking unit 12” as “collating means”); and

a sending means for sending a notice of coincidence as data to a mating party when a collation result proves coincident (see page 11, lines 8 – 15 and page 29, lines 15 – 23),

wherein a communication between the user and a mating party is started through the manager after the mating party receives the notice of coincidence as data (see page 23, lines 5 – 10); Uchida discloses “authenticating executing device 2” as “mating party”).

wherein a password is sent as data to the mating party/manager after the notice of collation is sent to the mating party/manager, and the reference living body information is rewritten when the password is authenticated as correct on the mating party (see page 1, lines 23 – 25).

Regarding claims 2 and 12, Uchida teaches a wherein the reference living body information comprises n reference living body information, the collation living body information of the user comprises n collation living body information of the user, the collating means collates the n collation living body information with the n reference living body information, and the sending means sends the notice of coincidence as data to the mating party when all of collation results prove coincident (see page 8, lines 15 – 24).

Regarding claims 3 and 13, Uchida teaches wherein the reference living body information comprises n reference living body information, the collation living body information of the user comprises m collation living body information of the user, the collating means collates the m collation living body information with the n reference living body information, and the sending means sends the notice of coincidence as data to the mating party when at least one of the n reference living body information

coincides with at least one of the m collation living body information (see page 21, lines 14 – 27).

Regarding claims 4 and 14, Uchida teaches wherein the reference living body information comprises a plurality of kinds of reference living body information, the collation living body information of the user comprises a plurality of kinds of collation living body information of the user, the collating means collates the plurality of collation living body information with the plurality of reference living body information, and the sending means sends the notice of coincidence as data to the mating party when the plurality of kinds of collation living body information wholly coincide with the plurality of kinds of reference living body information (see page 29, lines 4 – 23, page 30, lines 19 – 27 and page 31, lines 1 – 29).

Regarding claims 5 and 15, Uchida teaches wherein the reference living body information comprises n reference living body information of a plurality of kinds, the collation living body information comprises m collation living body information of a plurality of kinds of a user, the collating means collates the m collation living body information with the n reference living body information, and the sending means sends the notice of coincidence as data to the mating party when at least one of each kind of collation living body information among the plurality of kinds of collation living body information coincides with at least one of each kind of reference living body information among the n reference living body information (see page 23, lines 5 – 23).

Regarding claims 6 and 16, Uchida teaches wherein the reference living body information comprises n reference living body information of a plurality of kinds, the collation living body information comprises m collation living body information of a plurality of kinds of a user, the collating means collates the in collation living body information with the n reference living body information, and the sending means sends the notice of coincidence as data to the mating party when all of the plurality of kinds of collation living body information coincide with all of the n reference living body information (see page 21, lines 14 – 27).

Regarding claims 8 and 9, Uchida teaches a causing means for causing the manager to send the notice of coincidence as data to a mating party (see page 24, lines 7 – 21 and page 29, lines 13 – 23),

wherein the communication between the user and the mating party is directly started after the mating party receives the notice of coincidence as data (see page 27, lines 21 - 27).

Regarding claims 10 and 27, Uchida teaches wherein a transaction is conducted between the user and the mating party (see page 1, lines 7 – 14),

wherein an identification of the user is requested only when the condition set to the mating party is satisfied (see page 28, lines 10 – 15).

Regarding claims 18, 28, 29 and 30, Uchida teaches wherein the reference living body information comprises at least one selected from the group consisting of a fingerprint, a palm print and a voiceprint (see page 35, lines 7 – 16).

Regarding claims 19, 31, 32 and 33, Uchida teaches wherein the collation living body information comprises at least one selected from the group consisting of a fingerprint, a palm print and a voiceprint (see page 35, lines 7 – 16).

Regarding claims 20, 26, 34, 35, 36, 52, 53 and 54, Uchida teaches wherein the palm print is a palm print of the whole palm or a palm print of a part of the palm (see page 35, lines 7 – 16).

Regarding claims 23, 43, 44 and 45, Uchida teaches a portable information terminal is used (see page 35, lines 17 – 22).

Regarding claims 25, 49, 50 and 51, Uchida teaches a personal computer is used (see page 1, lines 16 – 22).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21, 22, 24, 37 – 42, and 46 – 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida in view of USPN 6,219,793 issued to Yang Li et al (hereinafter “Li”).

Regarding claims 21, 37, 38 and 39, Uchida discloses the claimed subject matter as discussed in 1,7, 11 and 17 respectively. Uchida does not explicitly teach the storing means is a flash memory.

Li teaches the storing means is a flash memory (column 12, lines 20 – 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teaching of Li with the teaching of Uchida wherein the memory storage means is a flash memory. The motivation is that flash memory is capable of storing image data.

Regarding claims 22, 40, 41 and 42, Uchida discloses the claimed subject matter as discussed in 1,7, 11 and 17 respectively. Uchida does not explicitly teach the reading means is a photodiode or a charge coupled device.

Li teaches the reading means is a photodiode or a charge coupled device (see column 4, lines 50 – 65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teaching of Li with the teaching of Uchida wherein the reading means is a photodiode. The motivation is that photodiode can be read and transmitted in electronic form.

Regarding claims 24, 46, 47 and 48, Li teaches a cellular telephone is used (see column 4, lines 33 – 49).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1 – 20, 23, 25 – 36, 43 – 45, and 49 - 54 are rejected under 35 U.S.C. 102(a) as been anticipated by U.S. Patent 6,751,734 issues to Kaoru Uchida (hereinafter “Uchida”).

Regarding claims 1, 7, 11 and 17, Uchida teaches a communication system for distinguishing a user, said system comprising:

a storing means for storing reference living body information (see column 8, lines 30 - 35; Uchida discloses “fingerprint” as “living body”);

a reading means for reading collation living body information of the user (see column 8, lines 58 - 65);

a collating means for collating the collation living body information with the reference living body information (see column 8, line 66 – column 9, line 4; Uchida discloses “comparing means 12” as “collating means”); and

a sending means for sending a notice of coincidence as data to a mating party when a collation result proves coincident (see column 11, lines 46 – 64),

wherein a communication between the user and a mating party is started through the manager after the mating party receives the notice of coincidence as data (see column 9, lines 32 - 37; Uchida discloses “authenticating executing device 2” as “mating party”).

wherein a password is sent as data to the mating party/manager after the notice of collation is sent to the mating party/manager, and the reference living body information is rewritten when the password is authenticated as correct on the mating party (see column 1, lines 23 - 26).

Regarding claims 2 and 12, Uchida teaches a wherein the reference living body information comprises n reference living body information, the collation living body information of the user comprises n collation living body information of the user, the collating means collates the n collation living body information with the n reference living body information, and the sending means sends the notice of coincidence as data to the mating party when all of collation results prove coincident (see page column 3, lines 50 - 65).

Regarding claims 3 and 13, Uchida teaches wherein the reference living body information comprises n reference living body information, the collation living body information of the user comprises in collation living body information of the user, the

Art Unit: 2172

collating means collates the m collation living body information with the n reference living body information, and the sending means sends the notice of coincidence as data to the mating party when at least one of the n reference living body information coincides with at least one of the m collation living body information (see column 8, line 58 – column 9, line 4).

Regarding claims 4 and 14, Uchida teaches wherein the reference living body information comprises a plurality of kinds of reference living body information, the collation living body information of the user comprises a plurality of kinds of collation living body information of the user, the collating means collates the plurality of collation living body information with the plurality of reference living body information, and the sending means sends the notice of coincidence as data to the mating party when the plurality of kinds of collation living body information wholly coincide with the plurality of kinds of reference living body information (see column 11, lines 46 – 67 and column 12, lines 18 - 51).

Regarding claims 5 and 15, Uchida teaches wherein the reference living body information comprises n reference living body information of a plurality of kinds, the collation living body information comprises m collation living body information of a plurality of kinds of a user, the collating means collates the m collation living body information with the n reference living body information, and the sending means sends the notice of coincidence as data to the mating party when at least one of each kind of

collation living body information among the plurality of kinds of collation living body information coincides with at least one of each kind of reference living body information among the n reference living body information (see column 10, lines 32 - 50).

Regarding claims 6 and 16, Uchida teaches wherein the reference living body information comprises n reference living body information of a plurality of kinds, the collation living body information comprises m collation living body information of a plurality of kinds of a user, the collating means collates the in collation living body information with the n reference living body information, and the sending means sends the notice of coincidence as data to the mating party when all of the plurality of kinds of collation living body information coincide with all of the n reference living body information (see column 8, line 58 – column 9, line 4).

Regarding claims 8, 9 and 26, Uchida teaches a causing means for causing the manager to send the notice of coincidence as data to a mating party (see column 9, line 60 – column 10, line 6 and column 11, lines 55 - 64),

wherein the communication between the user and the mating party is directly started after the mating party receives the notice of coincidence as data (see column 11, lines 13 - 19).

Regarding claims 10 and 27, Uchida teaches wherein a transaction is conducted between the user and the mating party (see column 1, lines 9 - 15),

wherein an identification of the user is requested only when the condition set to the mating party is satisfied (see column 11, lines 27 - 34).

Regarding claims 18, 28, 29 and 30, Uchida teaches wherein the reference living body information comprises at least one selected from the group consisting of a fingerprint, a palm print and a voiceprint (see column 13, line 66 – column 14, line 7).

Regarding claims 19, 31, 32 and 33, Uchida teaches wherein the collation living body information comprises at least one selected from the group consisting of a fingerprint, a palm print and a voiceprint (see column 13, line 66 – column 14, line 7).

Regarding claims 20, 34, 35, 36, 52, 53 and 54, Uchida teaches wherein the palm print is a palm print of the whole palm or a palm print of a part of the palm (see column 13, line 66 – column 14, line 7).

Regarding claim 55, Uchida teaches an authentication apparatus for performing authentication of a user, said authentication apparatus comprising:

means for collecting a reference living body information of the user (see column 8, line 66 – column 9, line 4; Uchida discloses "checking unit 12" as "means for collating" which is the comparing means);

means for collating a collation living body information with the reference living body information of the user (see column 4, lines 48 – 56; Uchida discloses biometrics image checking means” as “means for collating living body”); and

means for sending a signal of performing authentication of the user outside when the collation living body information and the reference living body information of the user coincide (see column 4, lines 60 – 67; Uchida discloses “communication message sending means” as “means for sending signal”).

Regarding claim 56, Uchida discloses an authentication apparatus for performing authentication of a user, said authentication apparatus comprising:

means for collecting a reference living body information of the user (see column 8, line 66 – column 9, line 4; Uchida discloses “checking unit 12” as “means for collating” which is the comparing means);

means for collating a collation living body information with the reference living body information of the user (see column 4, lines 48 – 56; Uchida discloses biometrics image checking means” as “means for collating living body”); and

means for transmitting a signal of performing authentication of the user at least a mating party and a manager when the collation living body information and the reference living body information of the user coincide (see column 2, lines 3 – 6; Uchida discloses “infrared rays, radio waves, sound waves” as “means for transmitting a signal”).

Regarding claim 57, Uchida teaches the transmitting means send the signal of performing authentication of the user to at least the mating party and the manager (see column 5, lines 31 – 44).

Regarding claims 23, 43, 44, 45, 58 and 61 Uchida teaches a portable information terminal is used (see column 13, line 66 – column 14, line 7).

Regarding claims 25, 49, 50, 51, 60 and 63, Uchida teaches a personal computer is used (see column 1, lines 17 - 23).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21, 22, 24, 37 – 42, and 46 – 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida in view of USPN 6,219,793 issued to Yang Li et al (hereinafter “Li”).

Regarding claims 21, 37, 38 and 39, Uchida discloses the claimed subject matter as discussed in 1,7, 11 and 17 respectively. Uchida does not explicitly teach the storing means is a flash memory.

Li teaches the storing means is a flash memory (column 12, lines 20 – 27).

Art Unit: 2172

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teaching of Li with the teaching of Uchida wherein the memory storage means is a flash memory. The motivation is that flash memory is capable of storing image data.

Regarding claims 22, 40, 41 and 42, Uchida discloses the claimed subject matter as discussed in 1,7, 11 and 17 respectively. Uchida does not explicitly teach the reading means is a photodiode or a charge coupled device.

Li teaches the reading means is a photodiode or a charge coupled device (see column 4, lines 50 – 65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teaching of Li with the teaching of Uchida wherein the reading means is a photodiode. The motivation is that photodiode can be read and transmitted in electronic form.

Regarding claims 24, 46, 47, 48, 59 and 62, Li teaches a cellular telephone is used (see column 4, lines 33 – 49).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred I. Ehichioya whose telephone number is 703-305-8039. The examiner can normally be reached on M - F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 703-305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2172

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fred I. Ehichioya
Examiner
Art Unit 2172
July 19, 2004



SHAHID ALAM
PRIMARY EXAMINER